

## REMARKS

### A. Background

Claims 14, 16-21, 23-28, 30, 31, 38-47, 49-51, 55, 56, and 58-67 were pending in the application at the time of the Office Action with claims 16, 17, 25, 41, 44, 49, and 51 being withdrawn. Claims 14, 18, 21, 23, 24, 55, 56, 58, and 66 were rejected as being indefinite. Claims 19, 26-28, 31, 38, 39, 42, 43, 55, 56, 59, 60, and 62-67 were rejected as being anticipated or obvious over cited prior art. Claims 14, 18, 21, 23, and 24 were allowed while claims 20, 30, 40, 45-47, 50, 58, and 61 were objected to as being dependent upon a rejected base claim. By this response applicant has amended claims 14, 26, 28, 30, 45, 50, 55, 59, 62, and 64-67; cancelled claims 19 and 46 and added new claim 68. As such, claims 14, 16-18, 20, 21, 23-28, 30, 31, 38-45, 47, 49-51, 55, 56, and 58-68 are now pending in the application with claims 16, 17, 25, 41, 44, 49, and 51 being withdrawn.

### B. Proposed Claim Amendments

Applicant respectfully submits that the amendments to the claims are supported by Figures 17 and 22 as originally filed. As such, applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

### C. Rejection on the Merits

The Office Action rejects claims 14, 18, 21, 23, 24, 55, 56, 58, and 66 under 35 USC § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter. Applicant has herein amended claims 14, 55 and 66 so as to address the rejections raised in the

Office Action. The other claims were simply rejected for depending from one of claims 14, 55 and 66. Accordingly, in view of the amendments to claims 14, 55 and 66, applicant respectfully requests the withdrawal of the claim rejections under Section 112.

The Office Action rejects claims 19, 26-28, 31, 38, 39, 42, and 62-67 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,489,311 to Cipolletti. Of the rejected claims, claims 26, 38, 62, 64, and 65 are independent claims.

Cipolletti discloses a tibial prosthesis 13. With reference to Figures 1 and 4, prosthesis 13 includes a first member 10 that comprises a stem 12 having a flange 9 that outwardly projects from an upper end thereof. A bore 11 extends down into stem 12 from the upper end of stem 12. The lower end of stem 12 is closed so that bore 11 forms a closed socket. A tubular second member 20, a screw 40, and a shaft 32 from a trial member 30 are received within bore 11 during assembly. Screw 40 mechanically engages stem 12 by threading into shaft 32 at the bottom of bore 11 so as to be completely disposed within bore 11. Second member 20 encircles a portion of screw 40 and is also completely disposed within bore 11.

The Office Action equates the claimed “bearing plate” with flange 9, the claimed “stem” with stem 12, the claimed “fastener” with screw 40 and the claimed “tubular bone anchor” with screw 40. It is assumed that this last association of the claimed “tubular bone anchor” also with screw 40 is a typographical error in that the claimed “fastener” and “tubular bone anchor” cannot both correspond to the same screw 40. Furthermore, screw 40 is not a “tubular” member. It is assumed that the Office Action meant to equate the claimed “tubular bone anchor” with tubular second member 20 since second member 20 is the only “tubular” member.

Based on the foregoing interpretation, applicant submits that independent claim 26 is not anticipated by Cipolletti. Specifically, because screw 40 (claimed “fastener”) is completely

disposed within bore 11 of stem 12 when screw 40 is mechanically engaging stem 12, Cipolletti does not disclose or suggest “a fastener mechanically engaging with the stem so that at least a portion of the fastener is **disposed outside of the stem**,” as recited in claim 26. Likewise, because tubular second member 20 (claimed “bone anchor”) is completely disposed within bore 11 when second member 20 is encircling screw 40 (claimed “fastener”), Cipolletti does not disclose or suggest “a tubular bone anchor removably encircling at least a portion of the fastener so that at least a portion of the bone anchor is **disposed outside of the stem**,” as recited in claim 26.

Claim 38 has been amended to incorporate the limitations of claims 46. The Office Action states that claim 46 is objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Because claim 46 previously depended from claim 46, applicant submits that claim 38 is now allowable for the same reason that claim 46 was considered allowable in the Office Action.

As with claim 38, claim 62 has been amended to substantially recite the limitations of claim 46. Specifically, claim 62 has been amended to recite “at least one or more threads or barbs being formed on an exterior surface of the bone anchor.” Accordingly, applicant submits that claim 62 is allowable for at least the same reasons that claim 46 was considered allowable in the Office Action. Furthermore, applicant submits that tubular second member 20 does not have “at least one or more threads or barbs being formed on an exterior surface” thereof and thus cannot correspond the tubular bone anchor recited in claim 62.

Regarding claim 64, the Office Action equates the claimed “stem” with stem 12, the claimed “pocket” with bore 11 and the claimed “inlay” with second member 20. Under this interpretation, however, because bore 11 is formed within stem 12, Cipolletti does not disclose or suggest “the pocket being positioned outside of stem,” as recited in claim 64. Likewise, applicant submits that Cipolletti does not disclose or suggest “an inlay of porous bone ingrowth”

material being secured within the pocket,” as recited in claim 64. That is, Cipolletti does not disclose nor is there any motivation for forming second member 20 out of a “porous bone ingrowth material.”

Regarding claim 65, the Office Action equates the claimed “means for connecting a fastener to the stem” with threaded socket 16 of Cipolletti. However, because threaded socket 16 is formed **on the interior surface of stem 12 and within bore 11 which extends through flange 9**, Cipolletti does not disclose or suggest “means for connecting a fastener to the stem, the means comprising a threaded socket **formed on an exterior surface of the stem** so that the threaded socket **does not extend through the bearing plate**,” as recited in claim 65.

In view of the foregoing, applicant submits that independent claims 26, 38, 62, 64 and 65 are distinguished over the cited prior art and withdrawal of the rejection is respectfully requested. Likewise, claims 19, 27-28, 31, 39, 42, 63, 66 and 67 depend from claim 26, 38, 62, 64 or 65 and thus incorporate the limitations thereof. As such, applicant submits that claims 19, 27-28, 31, 39, 42, 63, 66 and 67 are distinguished over the cited prior art for at least the same reasons as discussed above with regard to claims 26, 38, 62, 64 and 65.

The Office Action rejects claims 55, 56, 59, and 60 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,866,683 to Gerbec. With regard to Figure 20A of Gerbec, the Office Action equates the claimed “stem” with member 20, the claimed “fastener” with shaft 90, the claimed “bone anchor” with member 30, and the claimed “nut” with nut 31. Based on the foregoing interpretation, nut 31 of Gerbec biases against member 20 (claimed “stem”) when nut 31 is threaded onto shaft 90. However, nut 31 is spaced apart from and has no mechanical interaction with member 30 (claimed “bone anchor”). As such, Gerbec does not disclose or suggest “a nut having a passage extending completely therethrough, the nut being removably threaded onto the fastener so as to **bias against the tubular bone anchor**,” as recited in claim 55.

With regard to claim 59, applicant again notes that the Office Action equates the claimed “fastener” with shaft 90. With reference to Figure 20A of Gerbec, shaft 90 only has threaded engagement at one end. As such, applicant submits that Gerbec does not disclose or suggest “an elongated fastener having a first end and an opposing second end, the first end being removably **threaded to the bottom surface of the bearing plate** without extending through the bearing plate” and “a nut having a passage extending completely therethrough, **the nut being removably threaded onto the fastener from the second end of the fastener**,” as recited in claim 59.

In view of the foregoing, applicant submits that independent claims 55 and 59 are distinguished over the cited prior art and withdrawal of the rejection is respectfully requested. Likewise, claims 56 and 60 depend from claim 55 or 59 and thus incorporate the limitations thereof. As such, applicant submits that claims 56 and 60 are distinguished over the cited prior art for at least the same reasons as discussed above with regard to claim 55 and 59.

The Office Action rejects claim 43 under 35 USC § 103(a) as being obvious over the Cipolletti patent in view of what the examiner considers would be known to those skilled in the art. Claim 43 depends from claim 38 and thus incorporates the limitations thereof. As such, applicant submits that claim 43 is distinguished over the cited prior art for at least the same reasons as discussed above with regard to claim 38.

Claims 14, 18, 21, 23, and 24 were allowed in the Office Action while claims 20, 30, 40, 45-47, 50, 58, and 61 were objected to only for being dependent upon a rejected base claim. As such, these claims are not discussed further.

#### D. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits

that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 14, 16-18, 20, 21, 23-28, 30, 31, 38-45, 47, 49-51, 55, 56, and 58-68 as now pending in the application with claims 16, 17, 25, 41, 44, 49, and 51 being withdrawn.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 5<sup>th</sup> day of June 2008.

Respectfully submitted,

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